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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,510	02/27/2002	Fang-Tsch Frank Chang	505492000100	2164

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Jill A. Jacobson
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304

EXAMINER

SNEDDEN, SHERIDAN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,510

Applicant(s)

CHANG ET AL.

Examiner

Sheridan K Snedden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 4 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-77 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-42, 44-45, 53-56, 66, 68, 69, and 75-77 drawn to a polynucleotide of SEQ ID NO: 1, fragment thereof not contained in either SEQ ID NO: 2 or 3, or a sequence that would hybridize to SEQ ID NO: 1, and method of using polynucleotide in determining the condition that permits pearl formation by measuring nucleic acid expression levels.

Group II, claim(s) 43, 72, 73, and 74, drawn to a polypeptide encoding by a polynucleotide of SEQ ID NO: 1 fragment thereof not contained in either SEQ ID NO: 2 or 3, or a sequence that would hybridize to SEQ ID NO: 1.

Group III, claim(s) 46, drawn to a polynucleotide of contained in SEQ ID NO: 1 and SEQ ID NO:2.

Group IV, claim(s) 47, drawn to a polynucleotide of contained in SEQ ID NO: 3.

Group V, claim(s) 48, drawn to a polynucleotide of contained in SEQ ID NO: 1 and SEQ ID NO:3.

Group VI, claim(s) 49-52, drawn to a polynucleotide encoding nacrein or Pinctada margaritifera and fragments thereof.

Group VII, claim(s) 57-59, drawn to an antibody.

Group VIII, claim(s) 60-65, 67, 70, and 71, drawn to a method of determining the condition that permits pearl formation by measuring protein.

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2. Upon thorough consideration of the claims, the examiner has determined that a lack of unity of invention exists, as defined in Rule 13.

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. Annex B, Part 1(b), indicates that "special technical features" means those technical features which as a whole define a contribution over the prior art. The inventions listed as Groups I and III – VI are directed to a polynucleotide, protein encoding or methods of using, that share the common special technical feature of the polynucleotide comprising a sequence within SEQ ID NO: 1. This common special technical feature is not a contribution over the prior art as it is taught by Matsushiro (US PATENT 5968772). Matsushiro teach a nucleic acid that comprises a 13-nucleotide fragment contained with SEQ ID NO: 1. Thus the invention of Groups I and III – VI lack unity of invention.

Additionally, Annex B, Part 1(e), indicates the permissible combinations of different categories of claims. Part 1(e(i)) states that inclusion of an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product is permissible. As such, Group I-VIII are directed to multiple products and methods not permissible for consideration for lack of unity.

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Advisory Information

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan K Snedden whose telephone number is (703) 305-4843. The examiner can normally be reached on Monday - Friday, 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone number for regular communications to the organization where this application or proceeding is assigned is (703) 746-3975.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

KAREN COCHRANE CARLSON, Ph.D.
PRIMARY EXAMINER

SKS
May 14, 2004

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